

Serial No. 09/406,729
Amendment dated September 21, 2006
Reply to Office Action of June 21, 2006

Docket No. CIT/K-0090

REMARKS/ARGUMENTS

Claims 1-13, 34-47, 49-60, 63 and 64 are pending in this application. By this Amendment, claim 10 is amended, and claims 63 and 64 are canceled without prejudice or disclaimer.

Claims 1-13, 34-47 and 49-60 stand rejected under 35 U.S.C. §112, first paragraph, for enablement, and claims 63 and 64 stand rejected under 35 U.S.C. §112, first paragraph, for written description. Claims 63 and 64 are canceled, and that rejection is now moot. As per rejection of claims 1-13, 34-47 and 49-60, this rejection is respectfully traversed.

The Patent Office indicates that claims 1 and 10 both recite “selecting the transport format according to the decided bearer service profile type.” However, claims 1 and 10 do not have such a recitation, and a rejection based on an incorrect recitation is erroneous. Further, claim 10 has been amended for clarification.

The specification discloses a bearer service profile type comprising a bearer service combination type, a bearer service class type, and environment items (Page 5, lines 7-8). Moreover, the bearer service combination type comprises one of seven (7) combinations including at least one of speech, circuit-data and packet-data (Page 5, lines 11-20). Since the transport format comprises a dynamic part and a semi-static part, the dynamic part attributes include a transport block size and transport block setup size, and the semi-static part attributes include a plurality of coding methods (Page 8, line 22 – Page 9, line 7). Based on such a

disclosure, one of skill in the art is able to select a transport format according to the bearer service combination type, e.g., selecting a transport format with a lower-rate coding method for the speech bearer service combination type to decrease the transfer delay, and selecting a transport format with a higher-rate coding method for the packet-switched bearer service combination type to decrease the transfer error rate.

Further, the bearer service class type is classified into four classes A, B, C and D according to a bit rate and a quality of service (Page 5, line 21 – Page 7, line 13). Similarly, since the transport format comprises a dynamic part and a semi-static part, the dynamic part attributes include a transport block size and transport block setup size, and the semi-static part attributes include a plurality of coding methods (Page 8, line 22 – Page 9, line 7). Based on such a disclosure, one of skill in the art is able to select a transport format according to the bearer service class type, e.g., selecting a transport format with a bigger block size and a lower-rate coding method for the class A bearer service class type due to the lower data rate and higher error rate for the class A, and selecting a transport format with a smaller block size and a higher-rate coding method for the class D bearer service class type due to a higher data rate and a lower error rate for the class D.

Moreover, environment items are classified into three models, e.g., an indoor environment model, an outdoor to indoor and pedestrian environment model and a vehicular environment model (Page 8, lines 1-6). Since the transport format comprises a dynamic part and

a semi-static part, the dynamic part attributes include a transport block size and transport block setup size, and the semi-static part attributes include a plurality of coding methods (Page 8, line 22 – Page 9, line 7). Based on such a disclosure, one of skill in the art can select a transport format according to the environment items, for example, selecting a transport format with a higher-rate coding method for the indoor environment model having a lower error rate and selecting a transport format with a lower-rate coding method for the vehicular environment model having a higher error rate. Hence, one of ordinary skill in the communication art can readily select a transport format according to the decided bearer service profile type based on the application disclosure.

That Patent Office contends that “the cited case laws related to 35 U.S.C. §112, first paragraph, failed to point to one single embodiment in the specification showing an example of how the invention actually works.” The cited case laws were provided in support for the position that the Patent Office has not met its initial burden to establish a reasonable basis to question the enablement.

The Patent Office further contends that “the provided tables A1-A4 and 5 in the declaration under 37 C.F.R. §1.132 may in no way be derived from what originally described in the specification.” However, tables A1-A4 and 5 were provided as examples for illustrative purposes only, showing various correlation based on the disclosure of the present application and knowledge of one of ordinary skill in the art as of October 1998. Without undue

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experimentation and based on the specification disclosure, one of ordinary skill in the art can choose the proper TFI/TFCI parameters for each service profile type.

The Patent Office also contends that “Applicant’s fail to point where supportive evidence for at least one single embodiment in the specification using the appendixes A through G.” Appendixes A through G support the argument that there was a plethora of information related to TFI/TFCI and that the Patent Office has not met its initial burden under 35 U.S.C. §112, first paragraph.

Per the Examiner’s request, we are enclosing a more legible copy of Appendix A, entitled “WIDEBAND CDMA FOR THIRD GENERATION MOBILE COMMUNICATION,” copyrighted 1998.

Further, attached herewith are additional publications of January 1999 (3GPP RAN S2.02 v.0.0.1) and April 1999 (TS 25.302 v.2.0.0.). As shown in these documents, the details of TFI/TFCI were known at that time. Further, as the Patent Office may be aware, such information does not “pop up” out of nowhere in a standardization document unless such information were previously studied, tested and known to one of ordinary skill in the art.

CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance. Favorable consideration and prompt allowance are

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earnestly solicited. If the Examiner believes that any additional changes would place the application in better condition for allowance, the Examiner is invited to contact the undersigned attorney, **Daniel Y.J. Kim**, at the telephone number listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. §1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 16-0607 and please credit any excess fees to such deposit account.

Respectfully submitted,
FLESHNER & KIM, LLP



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Attachments: Appendix A (pages 197-end)
3GPP RAN S2.02 v0.0.1 (1999-01)
TS 25.302 v2.0.0 (1999-04)

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APPENDIX A